

### **REMARKS**

The Office Action dated February 26, 2003 has been received, its contents carefully noted, and the applied citations thoroughly studied. Accordingly, the foregoing revisions to the specification and claims are tendered with the conviction that patentable contrast has now been made manifest over the known prior art and certain typographical inexactitudes have been rectified to provide better form. Accordingly, all rejections tendered by the Examiner in the above-referenced Office Action are hereby respectfully traversed and reconsideration is respectfully requested.

It is believed that the foregoing revisions to the claims are within the metes and bounds of the recently articulated Supreme Court *Festo* case, in that all equivalents susceptible to capture have been retained in that one skilled in the art, at the time of this amendment, could not have reasonably be expected to have drafted a claim that would have literally encompassed any other equivalent.

### **Specification**

The Examiner has objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Examiner has objected to the absence of subject matter contained in claims 11, 14, and 20. The specification has been amended as noted hereinabove to provide proper antecedent basis.

### **Claim Objections**

The Examiner has objected to claims 1, 3, 19, 20, and 22. All corrections requested by the Examiner have been made.

**Rejections under 35 U.S.C. § 112, first paragraph**

The Examiner has rejected claims 1 through 21, 24, and 25 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, has possession of the claimed invention.

The Examiner then cites limitations in claim 1 and 19 that refer to the concurrent games played. All of the limitations are disclosed with reference to the single game embodiment at page 10 of the specification.

Concurrent games are disclosed throughout the specification:

Page 4, lines 11-12: "this invention allows a player to engage in several gaming sessions concurrently"

Page 5, lines 10-11: "[i]t is a further object of the present invention to . . . allow[] a player to engage in several gaming sessions concurrently"

Page 11, lines 9-10: "[a] player can increase enjoyment by playing multiple BINGO cards simultaneously on the display 2"

Tournament play is disclosed at page 12, lines 3-8, which is different than playing concurrent games as noted above.

Regarding claim 25, "means for playing . . . first gaming events" refers to the playing of subsequent gaming propositions, as disclosed in the specification at page 11, lines 11-15. The plurality of first gaming events refers to a plurality of cards played, as noted above, and the second gaming event refers to any type of subsequent gaming event that is awarded through any one of the plurality of cards played.

**Rejections under 35 U.S.C. § 112, second paragraph**

The Examiner has rejected claims 1 through 21 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the Examiner notes ambiguity in the term “outcomes”. This claim has been amended to recite that indicia are generated, and that the indicia combine to produce outcomes for the game.

With regard to claims 1, 19, and 20, the Examiner notes the language “comparing each of said plurality of outcomes for each of said plurality of concurrent games to said ultimate winning outcome”, and states that “the specification teaches comparing the covered matrix (not outcome) with the ultimate winning outcome”.

The Examiner’s kind attention is directed to the fact that the covered matrix is the outcome. The ambiguity of the word “outcome” has been corrected as noted hereinabove; indicia are generated that combine to produce outcomes. The “outcome” compared to the payable is, in fact, the combination of indicia that are generated.

Regarding claim 20, “random output means” generate the indicia for the game. All claims reciting “random output means” have amended to make this relationship clear.

**Rejections under 35 U.S.C. § 103**

The Examiner has rejected claim 24 under 35 U.S.C. § 103 as being unpatentable over Falciglia (5,935,002).

Claim 24 has been cancelled.

The Examiner has rejected claims 1-7, 9-10, 12-13, 15-19, 21 and 25 under 35 U.S.C. § 103 as being unpatentable over Falciglia (5,935,002) in view of Nakamura (6,468,162).

Falciglia discloses a system and method of playing a BINGO-type game. A random number generator generates random numbers for play on a BINGO matrix playfield; another random number generator generates numbers to be covered in the matrix (col. 1, line 59–col. 2, line 27).

Nakamura discloses a game machine which is capable of storing personal information and character information on portable storage devices. Character information is used to play the games and may also be used in the context of trading cards, in which players may “collect” character “cards” and print them out in physical form (col. 2, lines 53-67). The personal information may be used to determine which characters a player may be eligible to acquire (col. 2, lines 7-52).

With respect to claims 1-5, 16, 17, and 19 at page 7 of the Office Action, the Examiner states that Falciglia discloses “comparing each outcome to an ultimate winning outcome [and] determining whether the plurality of outcomes match an intermediate winning outcome and awarding the intermediate winning [outcome]”. This is not correct. Falciglia discloses no hierarchy of winning outcomes and thus, could not possibly disclose any comparisons with respect to an “ultimate winning outcome” or “intermediate winning outcomes”.

Further, the Examiner states that “Falciglia discloses a subsequent event for a highest winning [sic]”. First of all, the passage cited by the Examiner regarding the “highest winning” refers to a multi-player game in which the *highest scoring player* is allowed to continue gaming (col. 7, lines 14-17), not the awarding of a bonus game

upon achieving an ultimate winning outcome. Falciglia discloses no subsequent game; the multi player game of Falciglia is played in a fixed number of rounds (col. 7, line 14), which is not analogous to offering a bonus game after winning a primary game.

With regard to Nakamura, the Examiner states that “Nakamura discloses saving information of a suspended game”. This is not true. Nakamura provides no mechanism for saving suspended games. Nakamura’s portable storage device saves character information (analogous to information contained on various popular trading card games). It may also save personal information, such as the number of games played, but no game details are ever contained in the portable memory devices.

Falciglia and Nakamura are each missing several elements of the claimed invention. Even if the prior art contained motivation to combine these references, applicant’s invention would not be obtained thereby.

With respect to claims 6, 7, 10, 13, and 25 the Examiner states that “Falciglia discloses a subsequent gaming event”. As noted hereinabove, this is not the case. Falciglia discloses one game, which may be played in a fixed number of rounds.

Regarding claims 9, 12, 15, and 21, the Examiner states that “it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a racing event or keno gaming event in the subsequent games of Falciglia in order to allow the player to play a racing or keno bonus game”. As noted hereinabove, Falciglia does not disclose subsequent gaming events. Falciglia discloses one game, which may be played in a fixed number of rounds.

Regarding claim 18, the Examiner states that "Falciglia discloses a three dimensional RxC matrix". The Examiner's kind attention is directed to an earlier Office Action in the instant case, mailed May 23, 2001, in which the Examiner did not find that Falciglia disclosed a three-dimensional matrix, but instead made the mere assertion that such a display would have been obvious. The fact is that Falciglia merely discloses a BINGO game and fails to recite several claimed elements.

The Examiner has rejected claims 11, 14, 20, and 22-23 under 35 U.S.C. § 103 as being unpatentable over Falciglia (5,935,002) in view of Nakamura (6,468,162) and Seelig (6,450,884).

Seelig discloses a Keno type game that utilizes numbered balls which are chosen at random.

With respect to claims 11 and 14, the combination of Falciglia and Nakamura is deficient as noted in detail hereinabove. Seelig does not cure these deficiencies, and thus, the present invention cannot be obtained using this combination. Even if all the elements were present in these references, no motivation exists to combine them. Falciglia discloses no subsequent or bonus games.

The Examiner's response to applicant's argument at page 11, last paragraph and page 12, lines 1-4 of the Amendment filed December 9, 2002, misses the point. Applicant's argument was that there was no motivation to combine references to save suspended games for later play. The Examiner's response included a convoluted reference to inclusion of a disk drive, presumably to indicate that one *could* include a disk drive, so one would store games.

“The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992).

In this case, the motivation for the gaming industry to include game-saving feature is not obvious. A gaming establishment is clearly not interested in having its patrons leave the gaming floor, but would rather have them remain on the floor and continue gaming. Gaming devices having varied themes, odds, and methods of play are some of the tactics commonly practiced. The idea of allowing a player to leave is not at all obvious with respect to this particular industry.

It is Black Letter Law the Patent and Trademark Office’s burden is to establish a prima facie case of obviousness. The Patent and Trademark Office has met its burden only when it fully describes: “1) What the reference discloses, teaches and suggests to one skilled in the art; 2) What the reference lacks in disclosing, teaching or suggesting vis-à-vis the claimed features; 3) What particular teaching or suggestion is being relied upon either via a reference itself or knowledge of person of ordinary skill in the art; 4) A statement explaining the proposed modification in order to establish the prima facie case of obviousness; and finally 5) the motivation behind the statement of obviousness which comes from three sources: a) teachings of the prior art; b) nature of the problem to be solved; or c) knowledge of persons of ordinary skill in the art”, see *In re Rouffet* 47 USPQ2d 1453 (Fed. Cir. 1998).

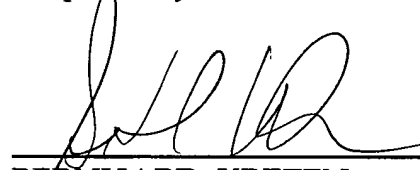
The Examiner has failed to meet these threshold requirements to establish prima facie obviousness. No motivation is provided by the Examiner, other than an assertion ‘that it would have been obvious to combine reference A with feature B in

order to practice feature B'. This circular reasoning does not meet the standards for patentability. In the absence of such a prima facie showing, the Examiner's rejection cannot stand.

In view of the foregoing, it is respectfully requested that the Examiner pass this case to issue. If, upon further consideration, the Examiner believes further issues remain outstanding or new ones have been generated, undersigned respectfully requests that the Examiner call undersigned to expeditiously resolve same.

Dated: August 19, 2003

Respectfully Submitted:

A handwritten signature in black ink, appearing to read 'Bernhard Kreten', is written over a horizontal line.

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